

REMARKS

The specification has been amended to alert the examiner to related, co-pending patent applications. Claim 1 is amended. Claim 10 is canceled. Claims 1-9 and 11-78 remain in the application.

The amendment to claim 1 is supported in the originally-filed specification at page 66, lines 11-20.

The Declaration is rejected for being defective on the basis that the inventors' signatures are missing. On March 23, 2001, in response to a Notice to File Missing Parts, the applicant submitted a Declaration signed by all inventors. A copy of the signed Declaration is submitted herewith, together with a copy of a return postcard, stamped by the US Patent Office acknowledging receipt of the document. Accordingly, the applicant respectfully requests withdrawal of the objection.

Objection is made to claim 6 for being virtually identical to claim 10. Claim 10 is canceled and the examiner is respectfully requested to withdraw the objection.

Claims 1-78 are rejected for obviousness over US Patent 5,809,242 ("Shaw") in view of US Patent 5,796,952 ("Davis"). This rejection is traversed for the following reasons.

Claims 1-9, 11-29, 50 and 51

Claim 1 is drawn to a system for distributing advertisements to a multiplicity of client devices, each configured for communications via a communications network, which comprises:

"an advertisement distribution facility that communicates with each of the client devices over the communications network, via a respective advertisement download communication link;

wherein each of the client devices downloads advertisements from the advertisement distribution facility via the respective advertisement download communication link; and

wherein each of the client devices communicates with a data communications service provider that is separate and independent from the advertisement distribution facility over the communications network via a respective data communications link that is separate from the respective advertisement download communication link."

Shaw discloses downloading of both e-mail and advertisements to a client computer by a single server system (a mail server system) over a single communication link (an e-mail communication link). In Shaw's system, advertisements destined for a

client computer are selected by, obtained by, and downloaded to the client computer by a mail server in a mail server system. The selected advertisements are downloaded, together with e-mail, by the mail server to a client computer on an e-mail link. See Shaw at col. 23, lines 52-53.

Shaw essentially discloses the Juno system described in the Background section of the application at page 5, lines 16-20, in which "both the advertisements and the e-mail messages are stored on a single e-mail system (e.g., JUNO stores both on a single, unique server which is assigned (bound) to the user when he/she first signs up for service), and are distributed to subscribers under the direction of a common control entity that is controlling all parts of the e-mail system."

In contrast, according to the invention of the rejected claims, a client device downloads advertisements from an advertisement distribution facility on an advertisement download link and conducts data from a data communications service provider that is separate from the advertisement distribution facility on a data communications link that is separate from the advertisement download link. Neither Shaw nor Marsh discloses or suggests that a client device "downloads advertisements." Neither Shaw nor Marsh teaches or implies that a client device downloads advertisements from an advertisement distribution facility "via a respective advertisement download communication link" that is separate from "a respective data communications link" with which the client device communicates with a data communications service provider.

The contention in the Office Action is that Shaw teaches "an advertisement distribution facility that communicates with each of the client devices over the communications network, via a respective advertisement download communication link (figures 1 and 6; col. 3, lines 42-50)." The applicants respectfully disagree. In fact, Shaw's Fig. 1 shows a server system, not an advertisement distribution facility. Furthermore, Fig. 1 shows a single, undivided communications link (102, 103, 105) between a client computer 101 and the server system 104, but does not describe or illustrate the link as an "advertisement download communication link." Fig. 6 of Shaw shows different types of information transferred between the client computer 101 and the mail server system 104; but no communication links are shown. However, the description of Fig. 6 suggests that all of the information types, including advertisement archives, are transferred together on an *e-mail* communication link, not an advertisement download communication link.

"Only when the user is ready to transmit or receive new e-mail messages does the client computer 101 establish a communications link with the server system 104, and the client computer is disconnected as soon as *all* information is transmitted and received. Thus, the system operates in "batch" mode." (Applicants' emphasis. Shaw at col. 23, lines 52-56)

At col. 3, lines 42-50, Shaw merely teaches that the server system 104 has communication facilities to enable client programs to connect with mail servers and server programs. The passage does not describe any advertisement distribution facility or any advertisement download communication link. Shaw does not teach or suggest an advertisement distribution facility that communicates with a client device via an "advertisement download communication link".

The further contention in the Office Action is that Shaw teaches "wherein each of the client devices downloads advertisements from the advertisement distribution facility via the respective advertisement download communication link (figures 1 and 6, col. 7, lines 36-51)." The applicants respectfully disagree. Neither Fig. 1 nor Fig. 6 illustrates a client computer that "downloads advertisements." Shaw at col. 7, lines 36-51 only sets forth that advertisements displayed to a user are not correlated with the user's e-mail. This passage does state that advertisements are "transferred to" (not "by") the user, but does not describe *how* advertisements are transferred to the user. The complete disclosure of Shaw's system includes the subject matter of US Patent Application Serial No. 08/636,745 (now US Patent No. 5,848,397 of Marsh), which is incorporated by reference at col. 7, lines 28-31 of Shaw. According to Marsh at col. 3, lines 28-30, the server system "includes an advertisement download scheduler which determines when the advertisements are transferred to each user." Thus, the only advertisement download activity disclosed by Shaw (via Marsh) resides in the "advertisement download scheduler" that "is located at the server system 104." See Marsh at col. 16, lines 19-28. In other words, according to Shaw (via Marsh), advertisements are downloaded to a client computer *by* a server. In contrast, claim 1 explicitly recites that "each of the client devices downloads advertisements from the advertisement distribution facility". Shaw does not teach or suggest a client device with any function that "downloads advertisements" from any facility whatsoever.

It is further contended in the Office Action that Shaw teaches "wherein each of the client devices communicates with a data communications service provider over the communications network via a respective data communications link that is separate from

the respective advertisement download communication link (figure 6, col. 1, lines 51-67)." The applicants respectfully disagree. Claim 1 provides at least two distinct facilities: an advertisement distribution facility and a data communications service provider that is separate and independent from the advertisement distribution facility. Claim 1 further provides least two distinct communication links: an advertisement download communication link and a data communications link that is separate from the advertisement download communication link. Shaw's Fig. 6 shows different types of information, including e-mail messages and advertisement archives, but the description of Fig. 6 teaches transferring all such information from a *single* server system 104 on a *single, undivided* e-mail communication link, not on from "separate and independent" facilities on "separate" communication links. See Shaw at col. 23, lines 52-56, quoted above, with emphasis noted. Shaw, in fact teaches away from using more than one communication link to transfer information between the client computer 101 and the mail server system 104 on the basis of cost: "This, of course, keeps the costs associated with maintaining a communications link, i.e., connect or line charges, low." See Shaw at col. 23, lines 57-59. Shaw does not teach or suggest a client device communicating with a data communications service provider that is "separate and independent" from an advertisement distribution facility via a data communications link that is "separate from" the advertisement download communication link by which the client device "downloads advertisements".

Davis does not rectify any of Shaw's deficiencies with respect to claim 1. Therefore, the combination of Shaw with Davis fails to satisfy at least the requirement of *prima facie* obviousness that the combination teach or suggest all elements of claim 1, and claims 2-9, 11-29, 50 and 51, which depend from claim 1.

#### Claims 30-36

Claim 30 further limits the system recited in claim 1 by limiting the advertisement distribution facility to:

"at least one ad server, each of which stores at least one of the advertisements to be downloaded;

at least one playlist server that generates at least one playlist," wherein a playlist "identifies a plurality of advertisements to be downloaded by at least one of the client devices."

The contention in the Office Action is that Shaw at col. 22, lines 42-57 teaches the system of claim 1 with the elements and limitations of claim 30. The applicants

respectfully disagree. Claim 30 is distinguishable from the combination of Shaw with Davis for the reasons given above in support of the patentability of claim 1 and for the following additional reasons.

Claim 30 establishes that the advertisement distribution facility in the system of claim 1 includes at least one ad server to store advertisements to be downloaded and at least one playlist server to generate at least one playlist. With the amendment of claim 1, that facility is “separate and independent” from the data communications service provider. Moreover, in the system of claim 30, a client device “downloads advertisements” from an ad server using a “playlist” generated by a playlist server. The playlist “identifies advertisements that are to be downloaded” by the client device.

A “playlist” is defined and enabled in the specification at page 33, line 19 through page 34, line 3 and page 35, line 20 through page 36, next-to-last line. A playlist is not defined, enabled, or even suggested in any of the references disclosed and cited in this or any related application. The reasonably skilled practitioner therefore had no playlist available at the time the invention was made. A “playlist server” is defined and enabled in the application at page 51, line 6 through page 55, line 12. Such a server is not defined, enabled, or even suggested in any of the references disclosed and cited in this or any related application. The reasonably skilled practitioner had no playlist server available at the time the invention was made.

Shaw at col. 22, lines 42-57 describes “a single client computer 101”. The passage does not teach or suggest any “server”, let alone at least one ad server that stores at least one advertisement to be downloaded and at least one playlist server that generates a playlist. The client computer 101 maintains an ads directory containing advertisements to be displayed by a user of a plurality of users. The directory is stored on the client computer, but the source of the directory is not identified. In all likelihood, the directory is created by the client computer. In any event, Shaw does not teach or suggest that the ads directory is generated by a “playlist server” or a server of any kind. Further, the ads directory contains advertisements that have already been transferred to the client computer (“one “ads” directory storing advertisements”); it does not identify “advertisements to be downloaded by” the client computer. In this passage, Shaw also describes “a list of known advertisements for each user” that is maintained by the client computer. See Shaw at col. 22, lines 50-54. There is no disclosure or suggestion in this passage that the list is generated by “at least one playlist server” or any other server. Further, the list evidently refers to advertisements in the ads directory; that is, the list

refers to advertisements that have already been transferred to the client computer. There is no disclosure or suggestion in this passage that the list “identifies a plurality of advertisements to be downloaded” by a client device from an ad server.

Davis does not rectify any of Shaw's deficiencies with respect to claim 30. Therefore, the combination of Shaw with Davis fails to satisfy at least the requirement of *prima facie* obviousness that the combination teach or suggest all elements of claim 30, and claims 31-36, which depend from claim 30.

Claims 37-49 and 52-78

Claim 37 further limits the system recited in claim 1 by limiting the advertisement distribution facility to:

“at least one ad server, each of which stores at least one of the advertisements to be downloaded, each advertisement being stored in a storage location designated by a source address;

at least one playlist server that generates at least one playlist, and transmits one or more of the generated playlists to each client device;”

wherein a playlist “identifies a plurality of advertisements to be downloaded by at least one of the client devices.”

The contention in the Office Action is that Shaw teaches the recited ad server and playlist server in Figs. 1 and 6 and teaches the playlists at col. 7, lines 3-15. The applicants respectfully disagree. Claim 37 is distinguishable from the combination of Shaw with Davis for the reasons given above in support of the patentability of claims 1 and 30 and for the following additional reasons.

Shaw in Fig. 1 illustrates a single server system with elements labeled as signup servers and mail servers. Neither this figure nor its description teaches a server system with any element denoted or described as “at least one ad server”, or a server system with any element denoted or described as “at least one playlist server”. Fig. 6 also illustrates a single server system, but without any elements. An advertiser 108 is illustrated, but is not described as a server. A database management system 106 (which is not shown in Fig. 6) is described as storing “advertisement information”, but no description of the information is given. The description of FIG. 6 does not teach or suggest a “playlist server that “generates at least one playlist” and transmits it to a client device. At col. 7, lines 3-15, Shaw discusses statistical information recorded by the client computer in an event log file that is communicated to the server system. However, the log file does not correspond to the claimed “playlist”. None of the log file statistical

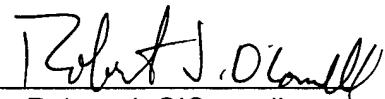
information described by Shaw "identifies a plurality of advertisements to be downloaded" by a client device. Furthermore, in Shaw the log file is maintained by the client device and communicated to the server system. However, in claim 37 a playlist is generated by a server and transmitted to a client device.

Davis does not rectify any of Shaw's deficiencies with respect to claim 37. Therefore, the combination of Shaw with Davis fails to satisfy at least the requirement of *prima facie* obviousness that the combination teach or suggest all elements of claim 37, and claims 38-49 and 52-78, which depend from claim 37.

Accordingly, in view of the amendment to claim 1 and the remarks made in this paper, it is submitted that all of the claims in this application are patentable distinguishable from the references of record, early notice of which is earnestly solicited.

Respectfully submitted,

Dated: 9-23-04

By:   
Robert J. O'Connell  
Attorney for Applicants  
Registration No. 44,265

QUALCOMM Incorporated  
5775 Morehouse Drive  
San Diego, California 92121

Telephone: (858) 651-4361  
Facsimile: (858) 658-2502